

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 10/708,406 Confirmation No.: 2405

Applicant: Garcia, *et al.*

Filed: 03/01/2004

TC/A.U. 3672

Examiner: Matthew J. Smith

Docket No.: 19.0372

Customer No.: 23718

Title: WELLBORE DRILLING SYSTEM AND METHOD

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Dear Sir:

Pursuant to 37 C.F.R. § 41.41, please consider the following Appellant's Reply Brief in the present application before the Board of Patent Appeals and Interferences.

The Applicant submits this Reply in response to Section (10)(D) in the Examiner's Answer, relating to the Examiner's response to the Applicant's non-analogous art arguments. Specifically, the Examiner has argued that the Applicant's invention is one of data transmission because the claims do not recite any drilling parameters. The Examiner further states that a "drilling operation is always related to the completion operation." Examiner's Answer at 7. The examiner supports this relationship by noting that wells are always produced through casing, that a drill bit may be chosen to create a borehole that is larger than the casing used in the same

borehole, and that the Assignee, Schlumberger Technology Corporation, has numerous patents that relate to both open hole and cased hole operations. *Id.* at 7–8.

The Applicant respectfully submits that the appealed claims relate to controlling a drilling operation, and not to a data transmission problem. For example, claim 1 recites “A method for drilling at least one wellbore...” and includes the step of “selectively advancing the downhole drilling tool into the earth.” Claim 1 specifically recites that the drilling tool is operated according to a wellsite setup.

The specification states that the “wellsite is setup such that the gauges, valves, switches and other devices of the surface and/or downhole systems are at an initial setting, referred to generally as the ‘wellsite setup.’ This wellsite setup may be selectively adjusted to control the drilling operation.” Specification at paragraph 28. “The modification of the wellsite setup, in turn, alters the drilling operation. For example, the drilling speed or trajectory may be adjusted based on the data received.” Specification at paragraph 48. Thus, the invention is particularly directed to a drilling operation and the problem being solved is a drilling problem.

The failure of the Applicant to include a specific drilling parameter in a claim does not mean that the invention is not related to a drilling problem. Instead, it reflects the nature of the invention as being related to a method for drilling control that encompasses all drilling parameters, and not specific parameters enumerated in a claim.

Regarding non-analogous art determinations, the Federal Circuit has said that there are two criteria for determining whether prior art is analogous:

- (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the same field of the inventor's endeavor, whether the reference still is reasonable pertinent to the particular problem with which the inventor is involved.

[*In re Clay*, 966 F.2d 656, 658–59 (Fed. Cir. 1992)]

A reference from a different field may be considered pertinent if the matter would have logically commended itself to the inventor's attention, considering the inventor's problem. *In re Icon Health and Fitness, Inc.*, 496 F.3d 1374, 1380 (Fed. Cir. 2007) (quoting *In re Clay*, 966 F.2d at 659.)

The Declaration of James Belaskie addresses both of these criteria. Because of the differences in drilling control and production well control, these two cannot be considered in the same field of endeavor. Further, the differences are so great that a reference related to production well control is not reasonably pertinent to the problem that the inventor has solved. For the reasons stated in the Declaration, Streetman does not logically commend itself to a person solving a drilling control problem.

In the Examiner's Answer, the Examiner stated that "[a] drilling operation is always related to the completion operation." Examiner's Answer at 7. The Examiner describes producing a well through casing that is installed in a drilled well. While drilling and production may be related in the sense that wells are drilled so that hydrocarbons may be produced, this, does not link the problems of controlling a drilling operation and controlling the flow through a production well.

Thus, Millheim and Streetman cannot be combined in an obviousness rejection because they Streetman is from a non-analogous art.

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Reply Brief Dated January 9, 2008

Please apply any charges not covered or any credits, to Deposit Account 19-0610
(Reference Number 19.0372).

Respectfully submitted,

Date: January 10, 2008 _____ /s/ James Kurka /

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